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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,569	05/03/2001	Wai Ming Hercule Kwan	2001P07771US	9693

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Siemens Corporation
Attn: Elsa Keller, Legal Administrator
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

HOOSAIN, ALLAN

ART UNIT PAPER NUMBER

2645

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,569

Applicant

KWAN ET AL.

Examiner

Allan Hoosain

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1,3,7-8,10-16,24-36,40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knuth** (US 5,646,979) in view of **Luneau** (US 5,526,406).

As to Claims 1,7-8,13-14,16,27-28,29-32,35-36,42-43 with respect to Figures 1-2, **Knuth** teaches a system for delivering an audio announcement in a telecommunication system, the system comprising:

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- a. a base station, 2, coupled to a plain old telephone service (POTS) line and having a transceiver, 14, for communicating over an air interface (Figure 1);
- b. a mobile unit, 42, operable to communicate with the base station over the air interface and having a speaker, 48 (Figure 2);
- c. a recorded message subsystem at the base station for recording a voice message and associating the voice message with synthesized telephone numbers (first caller id information) (Col. 4, lines 60-65);
- d. circuitry at the base station for receiving non-synthesized telephone numbers (second caller id information) from the POTS (Col. 4, lines 18-21);
- e. logic at the base station for selecting the voice message in response to the second caller id information and transmitting the voice message to the mobile unit (Col. 4, lines 55-63); and
- f. logic at the mobile unit for receiving the voice message and transmitting the voice message to the speaker (Col. 4, lines 38-46);

Knuth does not teach the following limitations:

“first caller ID information” and “second caller ID information”

Luneau teaches the limitations for screening incoming calls (Figure 7, labels 230,238). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add caller ID capability to **Knuth's** invention for screening incoming callers as taught by **Luneau's** invention in order to provide calling party announcement services to users.

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As to Claim 3, **Knuth** teaches the system of Claim 1 further comprising a plurality of mobile units (Col. 4, lines 55-56).

As to Claims 10,15, **Knuth** teaches the system of Claim 1:

Knuth does not teach the following limitation:

“wherein the logic compares the first and second caller id information to select the voice message”

Luneau teaches the limitations for matching caller Ids and selecting recorded name messages (Figure 7, labels 230,238,256). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add caller ID comparing capability to **Knuth's** invention for screening incoming callers as taught by **Luneau's** invention in order to provide calling party announcement services to users.

As to Claims 11-12,25-26,40-41, **Knuth** teaches the system of Claim 1 wherein the logic at the base station communicates the voice message from the base station to the mobile unit using a connection-oriented protocol (Col. 4, lines 35-40).

As to Claims 24,33-34, **Knuth** teaches the method of Claim 16 wherein playing the voice message comprises suppressing a second ring associated with an incoming call and playing the voice message in place of the second ring (Col. 4, lines 38-46).

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4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Knuth** in view of **Luneau** and further in view of **Carrera** (US 6,474,494).

As to Claim 2, **Knuth** teaches the system of Claim 1 further comprising a memory at the base station for recording the voice message;

Knuth does not teach the following limitation:

“a flash memory”

Carrera teaches flash memory (Figure 7, labels 230,238). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add flash memory capability to **Knuth's** invention for recording messages as taught by **Carrera's** invention in order to provide calling party announcement services to users.

5. Claims 4-6,9,17-20,37-39,22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knuth** in view of **Luneau** and further in view of **Swan et al.** (US 5,978,451).

As to Claims 4-6,9,17-20,37-39,22-23, **Knuth** teaches the system of Claim 3 wherein:

Knuth does not teach the following limitation:

“logic at the base station selects which of the plurality of mobile units is to receive the voice message”

Swan teaches logic at a PCC 10 (base station) which selects which telephones to receive distinctive ringing messages (Col. 8, lines 1-16). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add

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selection of phones capability to **Knuth's** invention for sending messages as taught by **Swan's** invention in order to provide calling party announcement services to users.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Knuth** in view of **Luneau** and further in view of **Fujioka et al.** (US 4,894,861).

As to Claim 21, **Knuth** teaches the method of Claim 20 further comprising:

Knuth does not teach the following limitation:

“transmitting the second caller id information in a text only form when the first and second caller id information do not match”

Fujioka teaches transmitting display messages (text) when caller ID do not match (Col. 4, lines 40-47). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add display capability to **Knuth's** invention for sending non-match caller ID messages as taught by **Fujioka's** invention in order to provide calling party announcement services to users.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Couse (US 6,006,088) teaches determining the identity of incoming calls in a cordless telephone interface device.

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Mizikovsky (US 5,559,860) teaches comparing caller ID in a mobile station and notifying called parties with selective alerts.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

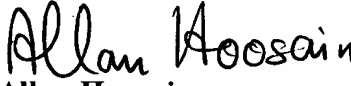
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Allan Hoosain
Primary Examiner
2/23/04